

Appl. No.: 10/067,255
Reply to Office Action of December 13, 2004

Docket No. 110344.101 US2

REMARKS

In the Office Action, the Examiner noted that claims 1-46 are pending in the application, and that claims 1-46 are rejected. By this amendment, claims 1, 37, 38 and 43-46 have been amended. Thus, claims 1-46 are pending in the application. The Examiner's rejections are traversed below.

Rejection of the Claims Under 35 U.S.C. Section 112, Second Paragraph

Claims 1-45 stand rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim, the subject matter that applicant regards as the invention. Applicant respectfully traverses this rejection.

The Examiner states in the rejection that the terms "immediate certainties," "near certainties," and "long-term possibilities" are unclear terms that render the claims indefinite. Applicant respectfully disagrees. As mentioned in the previous Response, these terms are clearly defined in the Summary of The Invention in the patent application, which states that:

"The agent is tactical because it considers not only immediate certainties and near certainties (e.g., if a hostile fighter is not shot at it will shoot at us) but also longer-term possibilities (e.g., if the bulk of our fighters are committed early, they may not be available should an enemy strike force appear in the future)."

Applicant further submits that it is well known by the software and the people who use it when hostile fire is imminent. It is also well understood what it means not to overcommit fighters early. The definitions are definite and present no difficulty to those skilled in the art.

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The Manual of Patent Examining Procedure (MPEP) clearly permits claims to be drafted in the format of the currently pending claims. For example, the MPEP states at § 2173.02 (8th ed. Rev. 1, Feb. 2003):

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

Similarly, the MPEP states at § 2173.02 (8th ed. Rev. 1, Feb. 2003).

The test for definiteness under 35 U.S.C. 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Oriokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). . . . If applicant does not accept the examiner's suggestion, the examiner should not pursue the issue.

The Applicant and Inventor would also like to point out that the very essence of tactics is precisely as defined, and the tactical (and intelligent) software agent is used for this very purpose. Scores of Department of Defense personnel have used the claimed agents and have found them to be very much tactical as well as helpful in tactical situations. In fact, according to the Inventor, being able to react, for example, to certain facts and to delay decisions is an example of why the agent is tactical and why the definitions are precise and not relative.

With respect to the Examiner's rejection of the claims as not being definite for not being specific enough to recite a single invention, Applicant respectfully traverses this rejection. For

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example, the Examiner objects to the claimed recitation of "configuring data, processing a combat situation and implementing a decision," as apparently being too broad for covering more than one invention. Applicant respectfully submits that this is an inappropriate application of the definiteness requirement under 35 U.S.C. §112, second paragraph. Applicant objects to the Examiner's attempt to force the applicant to rewrite the claims to include additional requirements/limitations. Applicant should be free to write their claims in any manner as they see fit. As stated by the Court of Customs and Patent Appeals:

By statute, 35 U.S.C. 112, Congress has placed no limitations on how an applicant claims his invention, so long as the specification concludes with claims which particularly point out and distinctly claim that invention.

In re Pilkington, 162 USPQ 145, 148 (C.C.P.A. 1969) (quoting *In re Steppan*, 156 USPQ 143, 148 (C.C.P.A. 1968)). Similarly, the Board of Patent Appeals and Interferences has stated:

In our judgment, a patent applicant is entitled to a reasonable degree of latitude in complying with the second paragraph of 35 U.S.C. § 112 and the examiner may not dictate the literal terms of the claims . . . Stated another way, a patent applicant must comply with 35 U.S.C. § 112, second paragraph, but just how the applicant does so, within reason, is within applicant's discretion.

In re Tanksley, 37 USPQ 2d 1382, 1386 (B.P.A.I. 1994).

The Board has also stated that, "It is well established that the invention claimed need not be described *ipsis verbis* in order to satisfy the disclosure requirement of §112." *Ex parte Holt*, 19 USPQ 2d 1211, 1213 (B.P.A.I. 1991). The CCPA has stated the following:

The absence of the limitation has a precise meaning. . . . This principle is the very basis of this court's consistent refusal to read limitations of the specification into the claims. . . . In our recent decision in *In re Wakefield*, . . . we considered an indefiniteness rejection involving the absence of a limitation. We reversed the rejection, stating . . . : "The scope of the claim is still definite, however, because each recited limitation is definite."

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In re Fisher, 166 USPQ 18, 23 (C.C.P.A. 1970). Accordingly, Applicant respectfully submits that the presently claimed invention is definite. Withdrawal of this rejection for these reasons is respectfully submitted.

In addition, at 21st Century Systems, Inc., the Assignee of the present application and for whom the Inventor is the founder, straight out of school programmers that are interviewed are provided with test questions, including a partial specification of the very same kind in the present application. Candidates are then asked to extend the specification, first at specification level and then with concrete code (in Java or C/C++). Most novice programmers have no difficulty whatsoever providing correct answers, and none to date have misinterpreted the provided questions.

Applicant would like to emphasize that the Examiner should not attempt to force the Applicant to redraft claims. As stated by the CCPA: "An applicant is entitled to claims as broad as the prior art and his disclosure will allow." *In re Rasmussen*, 211 USPQ 323, 326 (C.C.P.A. 1981).

Accordingly, Applicant respectfully submits that claims 1-46 satisfy the requirements under 35 U.S.C. Section 112, second paragraph. Withdrawal of this rejection is respectfully requested.

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CONCLUSION

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicant reserves the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicant hereby retracts any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicant specifically retracts statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

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For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

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AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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